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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,042	12/27/2001	Allan Stuart Algazi	1071X	9949
7590	01/24/2007		EXAMINER	
MARK I. KOFFSKY SYMBOL TECHNOLOGIES, INC. ONE SYMBOL PLAZA, MS/A6 HOLTSVILLE, NY 11742			PLUCINSKI, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	
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			01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/033,042	ALGAZI, ALLAN STUART
	Examiner	Art Unit
	Jamisue A. Plucinski	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,7-11,14,19-23,28-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,7-11,14,19-23,28-35 and 37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20070103</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 20-23 are objected to because of the following informalities: Claims 20-23 are objected to for failing to accomplish the objective as set forth in the preamble. The preamble discloses a method of establishing a service for package delivery, yet there is no package delivery being done, all that is being done is encoding information and electronically transmitting the information. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 7, 8, 20-23, 28-35 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to Claim 1: this claim appears to omitting essential steps in the method. The claim discloses a barcode is transmitted to a user, but never claims how the person gets the barcode to the scanner, is it printed out then scanned? Or does the user's terminal decode the barcode and compare it, if this is the case, then how can the barcode be scanned. It is unclear to the examiner where each of these steps are taken place

5. With respect to Claim 20: the applicant has claimed that "in response to the user ordering a package" yet the claim has not positively recited an ordering step. Therefore it is unclear when this step is actually being done, or if the step is a conditional step.

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6. With respect to Claim 20: the claim states "receiving biometric information and recipient information from a user" and then further claims "encoding biometric information into a two-dimensional barcode. Is the biometric information and the recipient information for different persons. Is the recipient the same as the user, which is submitting the biometric information. It is unclear if the recipient is the same as the user, and if they are different, how the user can give biometric information for another person.

7. With respect to Claim 20: the phrase "decoded to recover at least the user's previously provided biometric information" is indefinite. It is unclear to the examiner if the previously provided biometric information that same that is "received" previously in the claim. Therfore causing it to be unclear if the barcode is encoded with the biometric information received previously in the claim, previously stored, or both.

8. Claim 22 recites the limitation "the step of the user ordering a package" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. This limitation of ordering a package has not been positively claimed, therefore it is causing it to be unclear when this step is actually taking place,

9. Claim 23 recites the limitation "the biometric information". There is insufficient antecedent basis for this limitation in the claim. Is this the biometric information that is received, or previously provided?

Claim Rejections - 35 USC § 101

10. Claims 9-14 and 19, 28-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-14 and 19, 28-35 are drawn to an

apparatus, which is limited to structural limitations only. Claim 9 recites “a notifier” and Claim 10 recites “a presenter”, which these phrases appear to be a human who performs the activities such as providing, notifying and presenting. Claim 9 states the use of “a notifier” which notifies a user electronically that a package has arrived. The specification is silent as to what the “notifier” is. A human, can send an e-mail to a receiver that a package has arrived, therefore a human can be a notifier for notifying a user electronically that a package has arrived. Claim 10 discloses the use of “a presenter” for visual inspection. In order for there to be visual inspection, which leads to the presenter being a human, since there is visual inspection. A human or a human body part is considered to be non-statutory material, and is therefore not permitted to be positively claimed.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 2, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 42-53 of copending Application No. 09/759566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the present application and the copending application, is the use of electronically transmitting the barcode instead of a paper receipt. It is old and well known in the art the use of electronically transmitting shipping labels or a tracking number with a barcode.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's arguments, see Pages 8-12, filed 6/16/06, with respect to the prior art references not teaching electronically transmitting a 2 dimensional barcode, encoding biometric information to the user have been fully considered and are persuasive. The prior art rejection has been withdrawn. However, new rejections based on indefiniteness and clarity, have now been applied to the claims, as outlined above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Plucinski
Patent Examiner
Art Unit 3629